

REMARKS

The specification has been amended to make a minor wording change in paragraph [0008] and to eliminate a specific reference to claim 1 in paragraph [0009] in favor of a recitation of the actual elements of that claim.

Claims 1-20 were pending at the time of the mailing of the outstanding Office Action. By this amendment, claims 2-10 and 13-18 have been cancelled without prejudice or disclaimer as to the subject matter contained therein. Claim 1 has been amended. New claims 21-27 have been added.

In the Office Action of 18 July 2005, the Examiner rejected claim 20 under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. The Examiner cited the battery and circuit as being omitted elements. However, claim 20 depends from and includes all the limitations of claim 1, which clearly recites these elements. Withdrawal of this rejection is respectfully requested.

The Examiner also rejected claims 1-20 under 35 U.S.C. § 102(b) as anticipated by US Pat. No. 6,445,948 to Somdahl et al. (hereinafter "Somdahl"). To anticipate a claim, a reference must teach all elements of the claim (MPEP § 2131). Claim 1 has been amended to recite the presence of structures that compensate for discharge-induced swelling of the battery; and the structures include free spaces adjacent to the peripherally extending narrow side of the battery. Support for this amendment may be found in Figs. 2a, 2b and 6 and paragraphs [0036] and [0041]. The Applicants maintain that Somdahl neither teaches or suggests such structures but rather provides "a retainer 386" which is designed to "prevent swelling of the battery 380 from contacting and possibly damaging electrical components 364." Therefore, one can see that the structures of Somdahl are designed more to restrict swelling of the battery than to compensate for it, as the free spaces of the present invention provide. For this reason, Somdahl can not be said to teach or suggest all the elements of claim 1.

Claims 21 - 27 have been added and likewise distinguish over the prior art. Claim 21 recites structures that compensate for discharge-induced swelling of the battery where these structures include joining elements between the battery and the circuit that permit movement of the circuit relative to the battery. Contrary to the Examiner's assertion, Somdahl does not teach or suggest an electromedical implant comprising joining elements between the battery and circuit where those elements allow a relative movement of the circuit with respect to the battery. Somdahl provides attachment means without teaching or suggesting any allowance of movement of the circuit relative to the battery. To the contrary, the specific examples of Somdahl, "adhesive, tape, clamp or other mechanical attachment device" (column 14, lines 61 - 63) not only do not suggest relative movement, but suggest an absence of relative movement, thereby teaching away from the invention as recited in claim 21.

Claims 22 - 26, which depend from and include all the limitations of claim 21, recite additional elements that further distinguish over Somdahl. For example, claim 24 recites that the circuit extends over > about 80% of the flat side of the battery. Somdahl provides a medical device where a capacitor (365), which is an integral part of the circuit, is laterally adjacent to the battery (380) on the battery's peripherally extending narrow side, rather than being > about 80% overlapping on the flat side of the battery. Additionally, claims 26 and 27 recite that a connection between the battery and the circuit is provided by a lead-through duct, a feature neither taught or suggested by Somdahl. Support for new claims 21 - 27 may be found in paragraphs [0037] - [0039], [0043], [0045] of the specification, Figs. 8a - 8f, and the claims as originally filed. The Applicants maintain that claims 21 - 27 patentably distinguish over the prior art.

In view of the foregoing arguments the applicant submits that the claims are in a condition to permit allowance. Therefore, the Applicants request issuance of a Notice of Allowance.

Ser. No. 10/680,726

Amendment in response to Office Action of 18 July 2005

Atty Docket 117163-93

The outstanding Office Action was mailed on 18 July 2005. This Response is believed to be timely with no fees due. However, the Commissioner is authorized to charge any fee or to credit any overpayment associated with the filing of this paper to Deposit Account 15-0450.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John J. Cunniff", with a stylized flourish at the end.

John J. Cunniff
Reg. No. 42,451

Hahn Loeser & Parks LLP
One GOJO Plaza
Suite 300
Akron, OH 44311
330-864-5550

Fax 330-864-7986

jcunniff@hahnlaw.com